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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,082	06/27/2000	Steven M. Bessette	WFG-4380-107	4329
23117 7590 04/14/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
AFREIMOVA, VERA				
ART UNIT		PAPER NUMBER		
1657				
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04/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/604,082

**Applicant(s)**

BESSETTE ET AL.

**Examiner**

Vera Afremova

**Art Unit**

1657

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4, 19, 45, 51, 53 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 19, 45, 51, 53 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 1/29/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/28/2008 has been entered.

Claims 4, 19, 45, 51, 53 and 55 as amended (1/28/2008) are pending and under examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 19, 45, 51, 53 and 55 as amended are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07145598, US 4,759,930 (Granirer et al.), the IDS document "Pesticidal and Toxic Chemical News" from PROMT database (June 1994; database PROMT accession number 94:375291) and Kalisch (IDS reference. Cockroach control manual. 1995, pp. 30-35).

Claims are directed to a method for killing insects or arachnids wherein the method encompasses one step of contacting the insects or arachnids with a pesticidal composition comprising a pesticidally acceptable carrier and an active ingredient that is either a) rosemary oil with phenethyl propionate or b) rosemary oil with peppermint oil with phenethyl propionate or c)

rosemary oil with peppermint oil. Some claims are further drawn to the insects such as cockroaches and ants.

JP 07145598 discloses a method for disinfecting or controlling household pests including arachnids or mite (official translation page 14/25, par. 0016, line 14) by applying to a desired pest control location a pesticidal composition comprising 1) a pesticidally active ingredient with rosemary oil and peppermint oil and 2) a carrier in a form of additional plant oils (see English abstract; see official translation page 3/25 at section “purpose” and paragraphs 0020 and 0022). The method of the cited patent comprises identical active step of contacting household pest by placing composition in a pocket or in a chamber (translation par. 0016) where pest control is desired. The cited patent teaches a disinfection effect of the composition (English abstract, for example) and, thus, the cited composition is reasonably expected to have some killing effect as intended for the composition of the claimed method.

JP 07145598 is lacking disclosure about killing cockroaches and ants. However, the cited US 4,759,930 (Granirer et al.) discloses method of killing insects including cockroaches by applying composition derived from rosemary leaves and peppermint leaves (see examples 2, 4, 10, 12, 13, etc). The leaves of rosemary and peppermint obviously contain essential oils at least in some amounts.

The cited JP 07145598 is lacking disclosure related to the use of phenethyl propionate in the compositions in the method for controlling or killing the household pests.

However, the cited document “Pesticidal and Toxic Chemical News” from PROMT database teaches that all presently claimed components including rosemary oil, peppermint oil and phenethyl propionate are pesticidally active ingredients. The other cited reference by Kalisch

also teaches that essential oils such as phenethyl propionate and oil of rosemary show contact toxicity on cockroaches (page 35, col. 2, par. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to combine rosemary oil, peppermint oil and/or phenethyl propionate in any combination in the pesticidal composition with a reasonable expectation of success in exterminating household pests including insects and arachnids as suggested by the prior art because each of these ingredient alone or in combinations with others has been known and/or used as efficient pesticidal agent as adequately taught by JP 07145598; US 4,759,930 (Granirer et al.), the "Pesticidal and Toxic Chemical News" and Kalisch. One of skill in the art would have been motivated to add phenethyl propionate to pesticidal composition of JP 07145598 in order to disinfect pest contaminated area and, thus, to kill the household pests for the expected benefits in maximizing pest extermination. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

The claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 19 and 53 as amended remain/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of US 4,759,930 as explained in the prior office action.

The claims in the present application and the patent US 6,531,163 are each drawn to a method for controlling household pests including cockroaches by applying to the locus where control is desired a pesticidally effective amount of a composition with peppermint oil and phenethyl propionate. The claims of US 6,531,163 are broader and the patented method is open to the use of additional materials including additional pesticidal materials. The claimed method of the present application is different from the patented claims in that it requires a rosemary oil for controlling pests. However, it is recognized in the art that the pest controlling effects including pest-killing effects are produced by applying the peppermint oil-containing composition together with the rosemary oil-containing composition as adequately demonstrated by US 4,759,930 (see examples 12, 13 and 15-21).

Accordingly, the claimed methods in the present application and the patent US 6,531,163 are obvious variants. Thus, the inventions as claimed are co-extensive.

### ***Response to Arguments***

Applicant's arguments filed 1/28/2008 have been fully considered but they are not all found persuasive.

With regard to the claim rejection under 35 USC § 103 applicant appears to argue that the cited JP teaches a disinfecting effect of composition comprising several essential oils besides rosemary oil and peppermint oil unlike to the claimed method that is limited to rosemary oil and peppermint oil as the sole active ingredients and, therefore, one of skill in the art would not have been provided with a suggestion and/or motivation to select active ingredients in the combination as claimed for killing pests such as insects and arachnids. This argument is not found particularly convincing with regard to the claim rejection under 35 USC § 103 because it is well known that it is prima facie obvious to combine ingredients that are taught by the prior art to be useful for the same purpose in order to form another composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually or in combinations for the same purpose in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Furthermore, when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting of," applicant has the burden of arguing and/or showing that exclusion of additional steps and/or some "active" components would effect the

basic novel and unobvious characteristics of the claimed invention. Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With regard to the double patenting claim rejection applicants argue that claims of US 6,531,163 are devoid of any use of rosemary oil. Yet, the patented invention is open to incorporation of additional active ingredients to the mixture of peppermint oil with phenethyl propionate and the cited patent clearly encompasses the use of additional essential oil. Rosemary derived essential oil is effective in method for combating household pests as adequately taught by the secondary reference. Thus, this claim rejection is proper. Applicants' intention to file Terminal Disclaimer is noted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber, can be reached at (571) 272-0925.



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The fax phone number for the TC 1600 where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 1600, telephone number is (571) 272-1600.

Vera Afremova

AU 1657

April 9, 2008

VERA AFREMOVA

PRIMARY EXAMINER

/Vera Afremova/

Primary Examiner, Art Unit 1657